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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,344	11/26/2003	Christian Alexander Lang	YOR920030480US1	8235

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Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/723,344	Applicant(s) LANG ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the Request for Continued Examination filed on 1/18/2007.
2. Applicant has canceled claims 5 and 15, amended claims 1, 16, 17 and 18.
3. Claims 1-4, 6-14 and 16-19 are pending in the case, claims 1, 16, 17 and 18 are independent claims.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 9/21/2006) has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/2006 has been entered.
5. Examiner's rejection of claims 5 and 15, made under 35 USC 102 in the *Claim Rejections – 35 USC 102* section of the previous office action (dated 9/21/2006) is withdrawn in view of the canceled claims.
6. Examiner's rejection of claims 1, 3, 8, 11, 12 and 18, made under 35 USC 101 in the *Claim Rejections – 35 USC 101* section of the previous office action (dated 9/21/2006) is withdrawn in view of the amended claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

8. Claim 19 remains rejected, and claims 1, 16, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. **Regarding claim 19**, the amendment filed 7/3/2006 adds the following limitations: *"usable in a subsequent search"* The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

Applicant argues that the new matter rejection of Claim 19, made under 35 USC 112 should be withdrawn, and indicates a section of the originally filed specification as support (see page 8, third paragraph of the response filed 11/28/2006). The examiner has reviewed the indicated section, and has failed to find support therein. Claim 19 is directed toward *"the annotated document is useable in a subsequent search"*. The indicated section of the specification is directed toward Figure 1, and

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describes a user issuing annotations, a mediator matching user annotation to allowed annotations by using a history memory and stored annotations, to generate a set of matched terms as output. The indicated section fails to describe an annotated document or a subsequent search. The rejection is maintained.

10. **Regarding claims 1, 16, 17 and 18**, the amendment filed 11/28/2006 adds the following limitations: *"the user need not consider any annotations when a single allowed annotation is automatically determined to match"* and *"the user need only consider the matching allowed annotation and select one of the matching allowed annotations"* and *"the user need not consider any annotations"* The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

12. Claims 1-4, 6-14 and 16-19 remain rejected under 35 U.S.C. 102(e) as being anticipated by Neal et al. US Patent 6,697,799, filed 10/24/2002, patented 2/24/2004 (hereinafter Neal).

13. **Regarding independent claim 1**, Neal discloses annotating a document by assigning a classification to the document. Neal recites: *"The present invention allows an item to automatically be classified using its attributes based on a classification schema and a knowledge base"* (column 2, lines 23-25). Neal discloses obtaining a user proposed annotation (in the form of a classification) to be associated with the document and automatically determining, in accordance with a knowledge base, whether the user-proposed annotation matches at least one allowed classification. Neal recites: *"the invention can include selecting a first attribute of the item, designating a first search strategy comprising the value of the*

first attribute applied to operate upon data records in a first database" (column 2, lines 25-28). Neal discloses a user proposed classification in figure 8, at reference sign 812 (shown as "Add").

Neal discloses automatically selecting a match when more than one match is found in Figure 6A, at reference sign 115 (shown as "*Can the Item Be Automatically Classified*"). Neal discloses annotating the document in Figure 1 at reference sign 17 (shown as "*Formatted Classified Content*").

Neal discloses automatically determining the annotation in Figure 4 at reference sign 21. (shown as "*Automatic Classification Knowledge Database*"). Neal discloses a first and second determining mode, where the annotation is selected by the user or automatically. Neal recites: "*The determination as to whether or not to automatically classify an item can be made using thresholds. The thresholds can be made configurable by a system manager depending upon the need for accuracy as balanced against the amount of operator interaction desired. In this approach, the confidence score at each search view is compare to a configurable threshold. If the score is above the threshold, then it is automatically classified. If it is below the threshold, then it is submitted to a user for human review and selection*" (column 11, lines 48-56).

14. **Regarding dependent claim 2**, Neal discloses notifying the user that the user-proposed annotation (in the form of a classification) does not match at least one allowed classification when a match is not found in Figure 2 at reference sign 114 (shown as "*Display Results (Even If 0 Found)*").

15. **Regarding dependent claim 3**, Neal discloses storing a user proposed annotation (in the form of a classification) match when a match is found in Figure 3 at reference sign 51 (shown as "*Updated Classification Knowledge Database*").
16. **Regarding dependent claim 4**, Neal discloses notifying the user that the user proposed annotation (in the form of a classification) matches more than one allowed annotation, when more than one match is found in figure 8 at reference sign 820 (shown as a list of a plurality of matches).
17. **Regarding dependent claim 6**, Neal discloses notifying the user of match results after each attempted matching operation in Figure 6C at reference sign 155 (shown as "*Present the Categories and Confidence score to a User*").
18. **Regarding dependent claim 7**, Neal discloses a predetermined number of matching operations in Figure 4 at reference sign 59 (shown as "*Search Method Definition*"), and wherein the figure discloses an exemplary number of 3 matching operations.
19. **Regarding dependent claims 8-10**, Neal discloses a history buffer of matches (claim 8), using the history buffer to update a set of allowed classifications (claim 9) and using the history buffer to disambiguate matches (claim 10) in Figure 3 at reference sign 43 (shown as "*Classification Reference Database*"), 51 (shown as "*Updated Classification Knowledge Database*") and 47 (shown as "*Standards Database*").

20. **Regarding dependent claim 11**, Neal discloses determining a closeness between the user-proposed annotation (in the form of a classification) and the allowed classification in Figure 4 at reference sign 75 (shown as “*Search Method Scoring Weights*”).
21. **Regarding independent claims 16, 17 and 18**, the claims are directed toward an apparatus, article of manufacture and a method, respectively, for the method of claim 1, and are rejected using the same rationale.
22. **Regarding dependent claim 19**, Neal discloses an annotated document that is usable in a subsequent search – see the abstract.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

24. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neal in view of Handschuh et al., S-CREAM – Semi-Automatic Creation of Metadata, copyright 2002 (hereinafter Handschuh).

25. **Regarding dependent claims 12-14**, Neal discloses obtaining a user proposed annotation (in the form of a classification), and automatically determining if the user-proposed annotation matches an allowed annotation from a knowledge base. Neal fails to disclose the knowledge base as a term graph. However Handschuh discloses the use of a term graph (claim 12), computing a distance between the user-proposed annotation (in the form of a classification) and an allowed annotation (claim 13) and a stemming operation (claim 14) in the diagram at the top of page 4.

Therefore it would have been obvious, to one of ordinary skill at the time the invention was made, to combine the annotation system of Neal with the term graph of Handschuh, in order to calculate the degree of separation between the user-proposed term and the allowed term, which would indicate to a system user the allowability of the proposed term.

Response to Arguments

26. Applicant's arguments filed 11/28/2007 have been fully considered but they are not persuasive.
27. Applicant argues that the new matter rejection of Claim 19, made under 35 USC 112 should be withdrawn, and indicates a section of the originally filed specification as support (see page 8, third paragraph of the response filed 11/28/2006). The examiner has reviewed the indicated section, and has failed to find support therein. Claim 19 is directed toward "*the annotated document is useable in a subsequent search*". The indicated section of the specification is directed toward Figure 1, and

describes a user issuing annotations, a mediator matching user annotation to allowed annotations by using a history memory and stored annotations, to generate a set of matched terms as output. The indicated section fails to describe an annotated document or a subsequent search. The rejection is maintained.

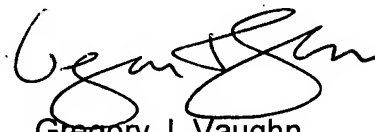
28. **Regarding claim 1**, applicant argues: *"Neal does not annotate a document with an allowed annotation, or with classification information"* (page 9, fifth paragraph, of the response filed 11/28/2006). Applicant is directed to the rejection of claim 1, as stated above. Neal is directed toward annotating documents, where the annotation is classification information. Neal discloses documents as items. Neal recites: *"As discussed above, the items can be tangible or intangible, documents, services, software or any other type of items capable of being described"* (column 3, lines 41-43). Neal discloses an item that has been annotated in Figure 3 at reference sign 17 (shown as "classified item")>

Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Vaughn
Patent Examiner
April 15, 2007